

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Gabriel COHEN	:	Confirmation Number: 8004
	:	
Application No.: 10/686,487	:	Group Art Unit: 2176
	:	
Filed: October 15, 2003	:	Examiner: J. Debrow
	:	
For: INDICATING FOCUS IN A PORTAL ENVIRONMENT	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated April 14, 2008.

The Examiner's response to Appellant's arguments submitted in the Second Appeal Brief of October 2, 2007, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellant relies upon the arguments presented in the Appeal Brief of October 2, 2007, and the arguments set forth below.

REMARKS

Prior to addressing the individual rejections, upon comparing the statement of the rejection found on pages 3-24 of the Fourth Office Action with the statement of the rejection found on pages 3-24 of the Examiner's Answer, Appellant have been unable to find any substantially differences.¹ Thus, Appellant proceeds on the basis that the Examiner's only response to Appellant's arguments presented in the Second Appeal Brief is found on pages 25-34 of the Examiner's Answer.

Rejection of claim 1 based upon Martin

On pages 5-8 of the Second Appeal Brief, Appellant presented arguments that the Examiner's newly cited reference of Martin fails to teach the claimed "an unfocused style," "focused style," and assigning styles, focused or not, to portlets. The Examiner's response to these arguments are found on pages 26 and 27 of the Examiner's Answer. In particular, the alleged basis for the Examiner's assertions is found in the paragraph spanning pages 26 and 27 of the Examiner's Answer and is reproduced below:

The Examiner concludes that the "gain focus" (*focus*) and "loss focus" (*unfocus*) features of the system disclosed in Martin inherently assigns a "*focused style*" to the cell having focus and an "*unfocused style*" to the cells not having focus in that the "focused" cell is distinguished (e.g., via highlighting) from the "unfocused" cells. The examiner notes that if the "focused" cell was not distinguished from the "unfocused" cells, then the user would be unable to tell which of the displayed cells has focus. (emphasis in original)

Not only has the Examiner relied upon an argument that is immaterial to the limitations at issue, the Examiner's reliance upon the doctrine of inherency is misplaced.

¹ One exception is a change in claim 12 from an obviousness argument to an inherency argument.

1 The Examiner's last statement as to if the focused/unfocused cells were not distinguished,
2 then the user would not be able to tell which displayed cell has focus is immaterial to the
3 limitations at issue. The issue being addressed is not whether Martin teaches giving a visual
4 indication as to a cell having focus. Instead, the issue regards how a portlet indicates input focus
5 in a portal environment.

6
7 The Examiner's reliance upon the doctrine of inherency to disclose the features at issue is
8 also misplaced for the reasons already presented by Appellant in the paragraph spanning pages 7
9 and 8 of the Second Appeal Brief. Not only has the Examiner not cured the deficiencies in the
10 Examiner's inherency argument, the Examiner has not even attempted to address or refute
11 Appellant's arguments.

12
13 As noted by Appellant on page 12 of the Second Appeal Brief regarding the Examiner's
14 cited reference of Fukuda,² the focus 704 is not applied to the frames 702 (i.e., the Examiner's
15 alleged portlets). Instead the focus 704 is a separate object that can be separately moved using
16 the cursor keys 202 of the remote control unit 116. Thus, the prior art shows at least one
17 different way for indicating focus than that claimed. Therefore, the Examiner cannot assert that
18 the missing elements, asserted by the Examiner to be inherent, are necessary found in the
19 teachings of Martin. Since the Examiner's inherency analysis is completely bereft of substantial
20 supporting evidence, the Examiner has failed to establish that Martin identically discloses the
21 claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

22
23

² Fukuda is similar to Martin in that both shows cells/frames in which focus is indicated.

1 Rejection of claim 12 based upon Fukuda

2 The Examiner's response to the arguments presented by Appellant on pages 8-14 of the
3 Second Appeal Brief are found 27-29 of the Examiner's Answer. At the outset, Appellant notes
4 that the Examiner does not respond to all of Appellant's arguments.

5
6 The Examiner's first set of comments are found in the paragraph spanning pages 27 and
7 28 and is reproduced below:

8 Fukda clearly disclose the focus style is configured such that a style sheet is used to
9 specify the style (focus or unfocus) of the focus, thus allowing a user to distinctly know where the
10 focus is applied. Fukda further discloses while viewing the multi screen program, the user moves
11 the focus to a desired streaming program on the screen using the cursor keys. To one or ordinary
12 skill in the art, it would be inherent that Fukda style sheet would be configured to indicate both a
13 focused and unfocused style. Therefore, the Examiner's conclusion is entirely factually supported
14 (0064; 0065; Fig. 3).
15

16 With the exception of a statement that a user employs cursor keys to move a focus, these
17 comments are substantially identical to the comments presented by the Examiner in the last full
18 paragraph on page 5 of the Examiner's Answer and the first full paragraph on page 5 of the
19 Fourth Office Action. As such, the Examiner's "response" does not address Appellant's
20 arguments, but instead, repeats the Examiner's prior assertions.

21
22 Also, the Examiner yet again relies upon an inherency argument that does not meet the
23 requirements for establishing inherency. Specifically, the Examiner has failed to present any
24 substantial evidence establishing that the features at issue must necessarily be present in the
25 teachings of Fukuda.

26
27 The Examiner further asserted the following in the first full paragraph on page 28 of the
28 Examiner's Answer:

1 Further, as established at the beginning of this section (Response to Argument) the
2 Appellant attempts to incorporate arguments related to superseded office actions and/or appeal
3 briefs. The Appellant makes reference to cited prior art which was not used in the rejection of this
4 claim of the currently appealed office action, e.g. Gajewaka, which has no relevance in the
5 currently appealed claim. (Appeal Brief, pages 9-14)
6

7 The Examiner's objections are a non-issue. As noted on page 10 of the Second Appeal Brief,
8 Appellant was reproducing arguments previously presented in response to a prior rejection based
9 upon Gajewska and Fukuda. The arguments previously presented by Appellant regard what
10 limitations Fukuda failed to teach. Since the Examiner is now rejecting the claim based solely
11 upon Fukuda, these previously-presented arguments are still applicable to the Examiner's current
12 rejection. Appellant's reference to Gajewska was found in the original arguments (which
13 Appellant stated was being reproduced), but did not factor into Appellant's arguments with
14 regarding to Fukuda. Thus, the Examiner's comments are directed to a non-issue.
15

16 The Examiner further asserted the following in the second full paragraph on page 28 of
17 the Examiner's Answer:

18 As previously stated, upon multiple examinations of the cited prior art, in response to
19 arguments and/or amendments set forth by Appellants or Applicants, it is typical of Examiners to
20 discover different interpretations or discover previously overlooked information/wording
21 pertaining to claimed limitations within the reference(s). Thus Appellant's argument as related to
22 superseded office actions and/or appeal briefs are moot.
23

24 In making this assertion, the Examiner is not being candid regarding the Examiner's rejection. In
25 the First Appeal Brief, Appellant was addressing arguments presented by the Examiner in the
26 Third Office Action as to the teachings of Fukuda. Appellants reproduced these arguments in the
27 paragraph spanning pages 9 and 10 of the Second Appeal Brief. The Examiner asserts that the
28 arguments are moot. However, this assertion by the Examiner is false.
29

1 The specific assertion by the Examiner being addressed by Appellant is already produced
2 on page 9 of the Second Appeal Brief, and this assertion was presented on page 3 of the Third
3 Office Action. In the first full paragraph on page 5 of the Fourth Office Action and the last full
4 paragraph on page 5 of the Examiner's Answer, the Examiner cited the same paragraph in
5 Fukuda to teach the same limitations. Thus, Appellant's arguments as to this particular claim
6 language and the Examiner's cited passage is not moot, as asserted by the Examiner.

7
8 On pages 28 and 29 of the Examiner's Answer, the Examiner presented the following
9 assertions:

10 Appellant further argues Fukuda teach the display of "*streaming programs 702, which*
11 *have not been established by the Examiner to be comparable to the claimed portlets.* (Appeal
12 Brief, page 10).

13 The Examiner disagrees.

14 Fukda discloses multi screen program display, wherein streaming programs are
15 represented by small views. Fukda also discloses wherein using the cursor keys, the user moves
16 the focus to a desired streaming program (small view) which he/she wants to view. Thus the
17 Examiner concludes the "small views" of which the streaming programs are displayed, is
18 comparable to the claimed portlets, not specifically the "streaming program" (0061; 0064; 0065;
19 Fig. 3). (emphasis in original)

20
21 Although not explicitly stated, the Examiner's claim construction for portlets is "small views."

22
23 This claim construction is improper for several reasons of which the first is that the
24 Examiner's claim construction lacks any basis in substantial evidence. For example, the
25 Examiner has failed to point to where this reference, or any other reference, supports the
26 Examiner's claim construction. Moreover, the Examiner's claim construction fails to consider
27 that the term portlet is a term-of-art, particular when used in conjunction with the terms of "a
28 portal" and "a portal environment," as recited in claim 12.³

29

³ A discussion of portals and portlets is found on pages 1-3 of Appellant's specification.

1 The Examiner's claim construction is akin to asserting that a bicycle identically discloses
2 a motorcycle because each are small vehicles with two wheels. The fact that two objects share
3 certain features does not necessarily lead to the conclusion that the two objects are identical.
4 Thus, the Examiner has neither set forth a proper claim construction for the term "portlet," nor
5 established that the stream program 702 of Fukuda identically discloses the claimed portlet.

6
7 In response to Appellant's arguments on page 13 of the Second Appeal Brief that the
8 Examiner is employing an obviousness analysis in a rejection based upon anticipation, the
9 Examiner asserted the following in the second full paragraph on page 29 of the Examiner's
10 Answer:

11 With regards to Appellant's assertion of the Examiner improper obviousness assertion,
12 the Examiner notes that this was an inadvertent error. (Appeal Brief, page 12)
13

14 Upon reviewing page 5 of the Examiner's Answer, Appellant notes that the Examiner has
15 now asserted the following:

16 (0064 Fukuda teaches a focus style is configured such that a style sheet is used to specify the style
17 of the focus. Using the broadest reasonable interpretation, the Examiner concludes that the style
18 sheet is used to configure both focused and unfocused styles. At the time of the invention it would
19 have been inherent to the skilled artisan that the unfocused style is typically considered as the
20 default style and therefore may or may not be defined within the content style sheet specification.).
21 (emphasis)
22

23 Yet again, the Examiner evidences an unfamiliarity with the requirements for establishing that a
24 particular limitation is inherently disclosed. Similar to every other attempt by the Examiner to
25 apply the doctrine of inherency, the Examiner has not produced an iota of evidence (substantial
26 or not) that establishes that one having ordinary skill in the art would recognize that the
27 limitations at issue are necessarily present in the teachings of the applied reference.

Moreover, by the Examiner's own admission, the Examiner establishes that the missing feature is not necessarily present in the teachings of Fukuda when the Examiner asserts that the unfocused style may not be defined within the content style sheet. Since, as admitted by the Examiner, the unfocused style may not be defined, Appellants is unclear as to how Fukuda inherently (i.e., necessarily) teaches "re-assigning said unfocused style sheet to said focused portlet which no longer has input focus." Thus, by the Examiner own admission, Fukuda fails to inherently teach the limitations at issue.

Rejection of claims 6-7, 10-11, and 13 based upon Fukuda in view of Gajewska

In the paragraph spanning pages 15 and 16 of the Second Appeal Brief, Appellants reproduced an argument first presented in the First Appeal Brief as to the Examiner's failure to establish a realistic rationale why one having ordinary skill in the art would modify Fukuda in view of Gajewska to arrive at the claimed invention. After citing well known case law, the Examiner stated the following in the paragraph spanning pages 30 and 31 of the Examiner's Answer:

In this case, both Fukuda and Gajewska are in the same or related field(s) of endeavor as the claimed invention. Further, both references teach focused and unfocused elements. However, Fukuda lacks the global indicator element in which Gajewska teaches in the form of a Focus list, thus suggesting a motivation to combine the references. (Gajewska, 0021; 0025; 0041; 0042, 100 in Fig. 6.)

The Examiner's first two sentences are not particularly material to establishing a common sense rationale for combining the references in an obviousness rejection. The fact that two references are allegedly within the same or related fields of endeavor or share certain elements does not necessarily establish a rationale for one having ordinary skill in the art to combine the references. Thus, the Examiner's sole asserted rationale for combining the references is that

1 "Fukuda lacks the global indicator element in which Gajewska teaches in the form of a Focus
2 list."

3
4 At best, the Examiner has established a rationale for including the Focus List 100 of
5 Gajewska in the teachings of Fukuda. Even if the Focus List 100 of Gajewska corresponds to the
6 claimed global indicator element that Examiner has not established a rationale for modifying
7 Fukuda to include the other limitations the Examiner has admitted is not disclosed by Fukuda.
8 However, the Focus List 100 of Gajewska does not correspond to the claimed global indicator
9 element. As described on in paragraph [0042] of Gajewska, the Focus List 100 is "a list of
10 components that have issued ... focus requests, but have not yet received focus notification
11 events" (emphasis added). On the contrary, the global indicator element, as claimed, specifies
12 the single focused portlet. Thus, the Focus List 100 of Gajewska is not comparable to the
13 claimed global indicator element.

For the reasons set forth in the Appeal Brief of October 2, 2007, and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 16, 2008

Respectfully submitted,

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